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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,079	11/30/2001	Youichi Mukogawa	401472	5374

23548 7590 06/23/2003

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/980,079

Applicant(s)

MUKOGAWA ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The applicant's claims are directed to "a detergent composition." The applicant introduces the term "petroleum solvent" in claim 1. The examiner understands the function of the composition. However, the examiner is unclear as to whether the "petroleum solvent" is part of the "detergent composition" or is considered a second fluid. In claim 1, the "petroleum solvent" is clearly not a part of the composition. However, in claim 4 the applicant describes a third solution which is a combination of the detergent of the petroleum.

4. The examiner will interpret the claimed composition to be only the terpene and the surfactant. The examiner will consider the combination of the detergent and the petroleum oil to be an intended use of the composition. The intended use of the composition is not considered a material limitation of the composition. Therefore, the examiner will consider the composition claimed to be only the surfactant and the terpene.

5. Also of confusion is the applicant's discussion of the "nonaqueous system." It is unclear to the examiner if this term is used to describe the composition or the petroleum solvent.

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6. It is also unclear the units describing the composition's solubility in diesel oil. The applicant's describe the solubility "of at least 10." It is unclear what the term "10" refers to as no units are provided.
7. It should also be noted that the language used in these claims is from a translation and could be more clearly written.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilmour et al (US 6,534,449).

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9. Gilmour teaches composition containing 85-99% d-limonene and 1-15% surfactant (see col. 4, lines 35-68). Gilmour teaches the addition of the compositions to diesel fuel (see table 11).
10. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts (US 5,741,502).
11. Roberts teaches nonaqueous compositions containing an oil and a surfactant. Roberts teaches various oils including d-limonene (see col. 4, line 63) in amounts ranging from 50-99% of the composition. Roberts further teaches the use of surfactants in amounts ranging from 5-19.5% of the composition (see col. 3, lines 20-23) and includes sorbitan fatty acid esters (see col. 5, line 12).
12. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Slyke (US 5,723,423).
13. Van Slyke teaches composition containing a 0.5-50% vol (see col. 8) surfactant and 0-90% oil (see abstract and col. 9). Van Slyke teaches surfactants including sorbitan fatty acid esters (see col. 2, lines 22-40). Van Slyke teaches solvents including d-limonene (see table III).
14. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Dekker et al (US 3,962,151).
15. Dekker teaches solvent based cleaners (see abstract). Dekker teaches in composition B (see cols. 5-6) a combination of 1% pine oil with kerosene and a surfactant.

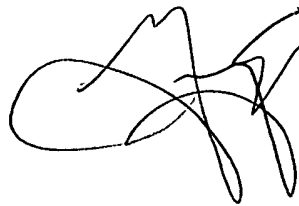
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945.

The examiner can normally be reached on 9:00-17:30 (m-f).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to be 'Gregory E. Webb', written in a cursive style.

Gregory E. Webb  
Primary Examiner  
Art Unit 1751

gw  
June 17, 2003